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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Barbara Dold

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

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DELIVERY MODE

09/01/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,863	Applicant(s) DOLD, BARBARA	
	Examiner GINA C. YU	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 28, 2010 has been entered.

All claim rejections made in the previous Office action dated December 19, 2009 are withdrawn in view of the claim amendment made by applicants.

New rejections have been made in this Office action.

Claim Objections

Claim 33 is objected to as the claim status indicator incorrectly states the claim has been "previously presented". Claim 33 contains new claim limitation "oil-in-water" in line 2, which has been proposed by applicant in after-final amendment submitted on May 10, 2010. Since the after final amendment has not been entered, the status of claim 33 is now "currently amended". See Advisory Action dated May 18, 2010, numbered statements 3 and 7.

Similarly, claim 62 is also objected to, as the deleted claim limitation "water-in-oil" in line 5 in fact had not been made a part of the claim. Although applicant proposed the claim limitation in the May 10, 2010 after-final amendment, the amendment was not entered.

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No correction will be required on the part of applicant; these objections have been raised only to clarify the claim status and the prosecution history.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations "oil-in-water" and "water-in-oil" in claims 33 and 62 also raise a new matter issue because applicant's original specification only discloses silicone-in-water and water-in-silicone-in-water emulsion on page 16 and all the examples are silicone-in-water emulsions. There appears to be no emulsions comprising oils other than silicone, particularly as applicant has indicated that the emulsions exclude other types of oils, as defined in claim 51. Although silicone oil is typically considered as a cosmetic oil as in the cited prior arts, in the present application applicant's original disclosure has specifically and narrowly defined the invention to be silicone and water emulsion only. By now defining the emulsions as "oil-in-water" the amendment effectively broadens the scope of the actual inventions and includes oil and water

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emulsions besides silicone and water emulsions. Applicant's original disclosure does not convey to a person of ordinary skill in the art that applicant was in possession of emulsions other than silicone and water emulsions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 is vague and indefinite as scope of the claim limitation broaden that of the base claim, claim 37. Claim already 37 limits the film-forming polymer combination of claim 33 to "a polyurethane acrylate copolymer". However, claim 38 then recites "the film-forming polymer" of claim 37 is selected from the group consisting of "a polyurethane polymer, polyvinylpyrrolidone polymer, acrylic polymer, acrylic polymer, acrylamide polymer, acrylic ester polymer, polyvinyl alcohol, polyvinyl acetate and mixtures thereof".

Claim 62 recites "optionally prior to or after the emulsification operation emulsifier is added and thickener and film-forming polymers are added and finally the substance is filled into containers". The claim is vague and indefinite as it is not clear which method step(s) are optional.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 33, 40, 43, 44, 47, 50, 51, 52, 54-56, 58-61 are rejected under 35 U.S.C. 102(e) as being anticipated by El-Nokaly et al. (US 7416735 B2).

El-Nokaly discloses an oil-in-water emulsion foundation having an aqueous phase comprising 5 wt % of at least two film-forming polymers (ethylene/acrylic acid copolymer and hydroxypropylcellulose); an emulsified phase comprising 23.74 wt % volatile silicone (cyclomethicone) and POE 23 lauryl ether, an emulsifier; and pigments. See Example 6; instant claims 33, 40, 51, 52, 58-60. The amount of pigments contained in the formulation includes 1.33 wt % of the non-charged pigments and 10.12 wt % of charged titanium dioxide, meeting instant claim 61. The composition also contains glycerin, a moisturizing agent, and propylparaben and fragrance, actives. See instant claims 43, 44, 50, 54, 55. The reference teaches that in the process of making the composition, Part C containing ethylene/acrylic acid copolymer is dissolved with part D comprising water, thus instant claim 56 is met.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 34-36, 39, 42, 57 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over El-Nokaly as applied to claims 33, 40, 43, 44, 47, 50, 51, 52, 54-56, 58-61 as above, and further in view of the teaching of the reference.

Although Example 6 of the reference uses water-soluble film forming polymers, the same reference indicates water insoluble or water dispersible film forming agents can be also used in the internal and external phases of the present compositions to give the desired end benefits of improving the long wear and non-transfer characteristics. See col. 25, lines 10 – 52. The reference discloses polyvinyl based polymers (PVP, PVP/VA), polyurethanes, acrylates copolymers (acrylates/acrylamide copolymers) are suitable film forming polymers well known in the art. See *Id*; instant claims 34-36, 39, 42.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the present invention to use water-soluble, insoluble or dispersible film forming polymers of El-Nokaly to make long-wear and transfer-free foundation emulsions as taught by the reference.

Regarding claim 62, El-Nokaly teaches ethylene/acrylate copolymer is dissolved in water before the emulsification, and hydroxypropylcellulose is added in the last stage. The prior art teaches pigments are added to the aqueous phase before the silicone and phase and aqueous phase homogenized. It is well settled in patent law that selection of any order of mixing ingredients is *prima facie* obvious. See In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). See also Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959). In this case, although El-Nokaly fails to teach mixing pigments and fillers with the volatile

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silicone, both the prior art and the present invention result in homogenized oil-in-water emulsion comprising pigments. In view of the holding of the precedents, altering the sequence of the adding the ingredients from the prior art is prima facie obvious.

Claims 37, 38, 41, 45, 46, 48, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over El-Nokaly as applied to claims 33-36, 39-40, 42-44, 47, 50, 51, 52, 54-62 as above, and further in view of Hanna et al. (US 5879668).

As discussed above, El-Nokaly teaches the disclosed film-forming polymers can be used in either internal or external phase of an emulsion, and illustrates O/W and W/O emulsions employing the same film-forming polymer, ethylene/acrylate copolymer. While the prior art teaches polyurethanes and acrylates are among the suitable hydrophilic film formers to make transfer-free makeup emulsions, the reference does not does not particularly mention combining polyurethane and acrylate polymers.

Hanna teaches a waterproof, long wear and transfer resistance W/O emulsion cosmetics comprising water-soluble or -dispersible film-forming polymers. Particularly mentioned are polycarbamyl polyglycol ester (a polyurethane), ammonium acrylate copolymer, sodium polymethylacrylate, etc. See col. 5, lines 4 - 22. The reference states, "mixtures of such polymers may be used" and teaches acrylic polyurethanes. Using the water-soluble or dispersible polymers in the range of 0.1-10 wt % is taught. Useful emulsifiers for the prior art emulsion include glyceryl stearate, alkyl dimethicone copolyol, polyglyceryl -4 isostearate, etc. See col. 4, lines 28 – 49; instant claim 53. Hanna further teaches adding light diffusing particles (nylon-12 particles) for

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camouflaging fine lines of skin and improving the skin feel when the product is applied to the skin. See col. 6, lines 3 – 13.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of El-Nokaly by selecting the water-soluble or water-dispersible film-forming copolymers, i.e., polycarbamyl polyglycol ester, or ammonium acrylate copolymer, and sodium polymethylacrylate, among the suitable film-formers as motivated by Hanna, because the former teaches polyurethanes and acrylate polymers are suitable film-formers for the invention; and the latter teaches a combination of polyurethanes with acrylate polymers or acrylic polyurethane copolymer to make waterproof, transfer-resistant makeup compositions. The skilled artisan would have had a reasonable expectation of successfully producing a stable transfer-resistant O/W cosmetic with a similar or enhanced efficacy because El-Nokaly teaches polyurethane and acrylate film-forming polymers may be incorporated either in the internal or external phase of an emulsion.

Response to Arguments

Applicant's arguments with respect to claims 33-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605.

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The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydown G. Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/
Primary Examiner, Art Unit 1617